

September 16, 2003
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Serial No.: 10/083,718
Filed: February 26, 2002
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-- REMARKS --

Claims 1-20 remain under consideration. The claims have not been amended in response to the Final Office Action.

CLAIM REJECTIONS UNDER 35 USC § 112

The following quotation from MPEP § 2111.03 forms part of the basis for traversing all rejections set for the in the Office Action:

2111.03 Transitional Phrases

The transitional phrases "comprising", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim.

The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.").

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

"A 'consisting essentially of' claim occupies a middle ground between closed claims that are written in a 'consisting of' format and fully open claims that are drafted in a 'comprising' format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988).

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The rejection of claims 1-20 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement, is traversed.

Independent claims 1 and 13, both include the transitional phrase "consisting essentially of." In paragraph 2 of the Final Office Action the Examiner states that he is rejecting claims 1 and 13, together with claims 2-12 and 14-20 depending respectively from claims 1 and 13, "[b]ecause claims 1 and 13, with the amendment concerning "consisting of"; do not recite a feed for the antenna and without the feed the recited device can not function."

Applicant's claims 1 and 13 utilize a "consisting essentially of" transitional phrase, and not the more restrictive "consisting of" transitional phrase upon which the Examiner improperly based his rejection. The Examiner has thus not provided a proper examination on the merits of Applicant's claims as amended in the Response submitted May 12, 2003, to the previous non-final Office Action dated February 12, 2003.

Applicant agrees with the Examiner's comment, as quoted above, that without a feed that the recited device cannot function. Applicant further notes, however, that the Examiner's comment serves as clear evidence that one skilled in the art would readily recognize that a device, as recited in claims 1 and 13, having an antenna consisting essentially of a substrate of dielectric material defining a longitudinal axis of the substrate and a surface of the substrate, and a plurality of electrically conductive elements disposed on the surface of the substrate to form a Yagi-Uda dipole array, would include a feed for the Yagi-Uda array.

As clearly stated at page 7, lines 1-2, of the Application, the feed of the Yagi-Uda antenna of Applicant's invention "may be made in any appropriate fashion known to those having skill in the art." The Application provides several examples of methods for providing a feed, using techniques known in the art, which are appropriate for use with a Yagi-Uda array as required by claims 1 and 13 and all claims depending therefrom, and are distinct from the prior art cited by the Examiner in the previous Office Action. See, Application page 7, lines 2-9. The

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manner in which the feed is made does not materially affect the characteristics of the Applicant's invention, and is therefore properly included within the scope of the "consisting essentially of" transitional phrase of these claims, even though the feed is not expressly recited.

Applicant provided extensive discussion in the Response submitted May 12, 2003 to the previous Office Action dated February 12, 2003, as to how additional elements in the cited prior art, would materially change the characteristics of the Applicant's invention, and would materially affect the basic and novel aspects of the Applicant's invention as claimed. Applicant restates that discussion herein by reference. These additional elements were excluded from the claimed invention by Applicant's disclosure, and by the use of the "consisting essentially of" phrase in the claims.

Claims 2-12, depending from claim 1, and claims 14-20, depending from claim 13, all properly further restrict the express limitations of claims 1 and 13, in accordance with the "comprising," and "consisting essentially of," transitional phrases used in claims 1 and 13, and are therefore also completely enabling and not subject to rejection under the first paragraph of 35 USC 112.

SUMMARY

Applicants believe that the application is in condition for allowance. Reconsideration and notification of allowance are respectfully requested.

For the reasons stated above, all rejections on the merits in the Final Office Action are improper. The Final Office Action is therefore both incomplete and premature. Should the Examiner not agree that the claims are in condition for allowance, Applicant hereby requests that the Final Office Action dated August 26, 2003 be withdrawn, and that the time period for a response to any substitute Office Action be reset accordingly.

In addition, should the Examiner elect to maintain his rejection, Applicant requests that the Examiner contact Applicant's counsel, Lawrence E. Crowe at 815-393-4644 to arrange a formal telephone interview.

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PROCEDURAL MATTERS AND FEES


Applicant believes that no fees are occasioned by the submittal of this paper. The commissioner is authorized, however, to charge any fees or credit any refunds occasioned by submittal of this paper to deposit account number 07-0960.

Dated: September 16, 2003

Respectfully submitted,
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